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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,619 11/15/99 SEITER

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QM32/0731

EXAMINER
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ARNOLD III, T

ART UNIT	PAPER NUMBER
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3728

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DATE MAILED: 07/31/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/423,619

Applicant(s)

Selter

Examiner

Troy Arnold

Group Art Unit

3728



☒ Responsive to communication(s) filed on Jun 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 26-30 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 26-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election with traverse of species II, shown in Figs 6-12, with claims 26-30 readable thereon, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that a single general inventive concept exists, and therefore all of the claims should be retained. This is not found persuasive because, contrary to the response, the mere existence of a "single general inventive concept" is not enough. The special technical feature, which is the common link between the different embodiments forming a single general inventive concept, must also, by definition, make a contribution over the art, i.e., be patentable. See MPEP 1893.03(d). In the case of the instant invention, the special technical feature is the cushioned layer in an insole. This has been determined not to make a contribution over the art, based on prior art references Pendergast and Geri, among others, therefore the single general inventive concept breaks down, and the restriction is maintained. Claims 21-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group I, shown in Figs 1-5, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

The requirement is still deemed proper and is therefore made FINAL.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how the instant invention aids the venous outflow of blood, as is claimed in claim 26, page 9. Since such alleged benefit has not been proven it is speculative and therefore cannot be claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "ovally homogenous" in claim 28 is vague and indefinite.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast. Pendergast teaches all the limitations of claim 26 except each (first, second, and third) cushioned layer being divided into individual fields. Pendergast does teach a cushioned layer 25-34 in the forefoot joint area which is divided into individual fields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the other areas, the metatarsus transition and metatarsus heel areas, of the insole of Pendergast for the purpose of providing the same benefits as are provided by the division on the forefoot area. Pendergast teaches all the limitations of claim 27; see item 20 in Fig 1.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Mauch or Sawyer. Both Mauch and Sawyer teach oval-shaped cushion layers in the heel area. See Mauch, Fig 1, item 8. See Sawyer, Fig 1, item a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel cushion layer of Pendergast oval-shaped for a variety of art conventional reasons, such as comfort under the heel. (See the cited art not relied upon for a number of different variations in shape and orientation of insole cushion layers.)

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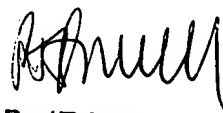
Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Shames. Shames teaches a sickle-shaped insole cushion layer 26 in the plantar arch area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a sickle-shaped cushion layer in the plantar arch area of Pendergast for the purpose of providing more arch support to the foot.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 29 above, and further in view of Fenton or Alianiello. Both Fenton and Alianiello teach cushioned layers recessed in a sole base body. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recess the cushion layers of Pendergast into a sole base body, if the sole base body 18 were thicker, for the purpose of better securing the layers to the base body, or for modulating the total amount of cushioning effect provided by the layers.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Troy Arnold whose telephone number is (703)305-0621. The Examiner can normally be reached Monday through Friday from 9:00 am until 5:00 pm EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

TGA

July 27, 2000



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700